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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,216	01/02/2004	Philip S. Siegel	067439.0157	1168

5073 7590 12/27/2006

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EXAMINER	
FISCHETTI, JOSEPH A	
ART UNIT	PAPER NUMBER
3627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/751,216	SIEGEL, PHILIP S.	
	Examiner	Art Unit	
	Joseph A. Fischetti	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8 and 10-28* is/are pending in the application.

4a) Of the above claim(s) *17-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8,10-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

Claims 1-5,7,8,10-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/817,353 in view of Roman et al and Haseltine '143. Roman et al. and Hasetine disclose obvious variants of the elements recited in claims 1-5,7,8,10-16.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5,7,8,10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roman et al. in view of Haseltine'143

Roman et al. disclose a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, a request to initiate return processing (customer clicks on RETURN), via a web access tool associated with the customer (access tool is read as the computer on which the consumer is using and hence it is associated with him);

Regarding the limitations of displaying to the customer via the web access tool, the transaction information comprising the list of the at least one item" and "receiving a selection of an item of merchandise from the list from the customer via the web access tool" reference is made to Roman et al. pp0017ClickReturns offering (displaying) replacement item which obviously must be the same item or like one.

It is the examiner's reading that a list of one still qualifies as a list. WEBSTER'S COLLEGIATE DICTIONARY TENTH EDITION defines a list, inter allia, as:

3. *n* the total number to be considered or included; *v.* ENUMERATE.

Clearly the display in Roman et al. lists at least the replacement product.

However, it is possible that the item presented in Roman et al. is not the item purchased. Thus, regarding the limitation of accessing a database to obtain transaction information associated with customer, the transaction identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, selection of an item of merchandise from the list from customer, reference is made to Haseltine'143 [0029] the bar code addressing a database which access information see par. [0028] o the sale. The bar code is deemed to access a list of at least one item corresponding to the item tagged by the code. It would obvious to modify Roman et al. to include Haseltine's information access feature the motivation being reducing the work required by the customer in remembering the details of the purchase.

Claim 2, wherein the displaying step is performed by displaying a return information web page (Roman et al. disclose page of click return.com is read as a web page).

Claim 3,4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is herby made final.

Claim 5: accessing a database to obtain customer information about the customer (see pp 0016 line 3), and wherein the displaying step includes displaying at least part of the customer information (Roman et al. disclose the offered replacement product and is read as part of customer information since it will reference the initial product).

Claims 7, 8: Roman et al. appears to be silent regarding a database dedicated to merchant return rules. However, Haseltine does disclose merchant specific rules for returning products which are in a database tied to the packing slip identifier. It would be obvious to modify the method of Roman et al. to include the merchant specific return rules, the motivation being the ability to accommodate different business practices.

Re claim 10/11: performed prior to the downloading step, of determining whether the return is valid (see pp 0016 line 2 submitted return is analyzed for fraud against a database). Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517

Claim 12: see pp 0016 Roman et al.; e-tailer establish parameter e.g. rules to determining whether the return is valid.

Claims: 13/14/16: a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged) by the processing center pp0022 line 8).

Claim 15: Roman et al. disclose pp0020 consumer prints a packing slip which obviously includes the step of downloading the data for printing a return label to the web access tool.

FINAL ARGUMENTS

Applicant argues "a selection by a user of either "return" or "exchange," as disclosed in Roman, is noted. The office action now cites to Roman et al. pp 0017 which presents to the customer a selection of items which serve as a replacement/exchange. These items must obviously be the same as that purchased. That is, the limitations of displaying to the customer via the web access tool, the transaction information comprising the list of the at least one item" and "receiving a selection of an item of merchandise from the list from the

customer via the web access tool" reference is made to Roman et al. pp0017ClickReturns offering (displaying) replacement item which obviously must be the same item or like one.

It is the examiner's reading that a list of one still qualifies as a list. WEBSTER'S COLLEGIATE DICTIONARY TENTH EDITION defines a list, inter allia, as:

3. *n* the total number to be considered or included; *v.* ENUMERATE.

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It is possible that the item presented in Roman et al. is not the item purchased. Thus, regarding the limitation of accessing a database to obtain transaction information associated with customer, the transaction identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, selection of an item of merchandise from the list from customer, reference is made to Haseltine'143 [0029] the bar code addressing a database which access information see par. [0028] o the sale. The bar code is deemed to access a list of at least one item corresponding to the item tagged by the code. It would obvious to modify Roman et al. to

include Haseltine's information access feature the motivation being reducing the work required by the customer in remembering the details of the purchase.

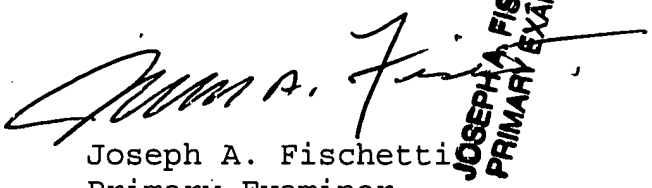
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number 571 272 6780.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (571) 272-6780.



Joseph A. Fischetti
Primary Examiner
Art Unit 3627